INDEX.

Petition for Writ of Certiorari..... 1

Matter Involved 1

Jurisdiction 2

Questions Presented 3

Reasons Relied On for Allowance of Writ..... 3

Conclusion 5

Brief in Support of Petition for Writ of Certiorari.... 6

Opinions Below 6

Jurisdiction 6

Statute Involved 6

Statement 6

Specification of Errors to be Urged..... 9

Argument 10

Conclusion 12

APPENDIX:

Sec. 4915 R. S. (35 U. S. C. Sec. 63)..... 13

TABLE OF AUTHORITIES.

Cases.

Grinnell Washing Mach. Co. v. E. E. Johnson, 247 U. S. 426, 62 L. Ed. 1196 (1918)..... 10

Pickering v. McCullough, 104 U. S. 318 (1881)..... 10

Statutes.

Judicial Code, Section 240(a), as amended by the Act of February 3, 1925, 28 U. S. C. 347(a)..... 2

35 U. S. C. 63, R. S. 4915.....1, 6, 13

AUG 7 1953

200045

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. .....

PETER A. ASSEFF

and

THE LUBRIZOL CORPORATION,

Petitioners,

vs.

JOHN A. MARZALL,
Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners pray that a Writ of Certiorari issue to the United States Court of Appeals for the District of Columbia Circuit to review the judgment entered by said Court on April 26, 1951 (R. 202A).

MATTER INVOLVED.

The judgment was entered upon an appeal taken by petitioners from the judgment of the United States District Court for the District of Columbia under date of October 17, 1949 (R. 22A) in an action brought by petitioners against Lawrence C. Kingsland, then Commissioner of Patents, under the provisions of 35 U. S. C. 63, R. S. 4915. By an order entered December 16, 1949 (R. 22A) John A. Marzall was substituted as party defendant as successor Commissioner of Patents.

By said action, individual petitioner Asseff as applicant and corporate petitioner The Lubrizol Corporation as his assignee, sought the allowance of an application for patent, then pending in the Patent Office, which had theretofore been refused by the Board of Appeals (R. 175A). The invention, as to which the application was thus refused, relates to a lubricating composition and is defined in several groups of claims. The present petition is concerned only with that group of claims, viz. 9 to 24 incl., which define the combined use in a lubricant of a specifically identified inhibitor or anti-corrosion agent with a detergent agent.

On the question of the patentability of these claims to a combination of ingredients, the Court of Appeals was sharply divided in opinion. Although the majority, by Circuit Judge Miller, recognized "that Cook's first application[1] said the detergent and anti-corrosion agent would offset each other," they nevertheless saw "no invention in adding to the Cook composition well known detergents or corrosion inhibitors." From this conclusion District Judge Wilkin (retired), sitting by designation, dissented:

> "The evidence is clear that Asseff was first in reducing to practice the specific ingredients that produced the desired result and constituted the invention. It seems contrary to the very spirit and purpose of patent law to allow the subsequent application of Cook the benefit of the earlier date of his application, the teaching of which was expressly contrary to the combination which constituted the invention."

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 3, 1925, 28 U. S. C. 347(a).

---

[1] This application, which disclosed such inhibitor or anti-corrosion agent as a sole additive, was abandoned in favor of an application (now patent No. 2,344,392, R. 183A), filed after Asseff's invention, in which Cook, evidently instructed by Asseff, indicated that his inhibitor might be used along with a detergent.

QUESTIONS PRESENTED.

1. Are the criteria of patentable invention different in the case of a combination of ingredients forming a new composition of matter from those in the case of a combination of mechanical elements forming a new machine?

2. Can an admittedly new composition be held "the result of a natural course of experimentation," where the teaching of the prior art was that component ingredients of the type involved were incompatible, i.e., could not be used together?[2]

3. Specifically, can an admittedly new composition of matter which is characterized by the use in combination of a component A (a specific inhibitor) and a component B (a detergent) which are now shown unexpectedly to cooperate in providing desirable results, far beyond the cumulative effect when they are used separately, be held anticipated by adding together separate prior art teachings which respectively relate to the use separately of said components A and B, when that teaching which relates to component A, the inhibitor, states specifically that such components A and B cannot be used together because each "tends to offset the action of the other"?

REASONS RELIED ON FOR ALLOWANCE OF WRIT.

1. There is urgent need for a pronouncement by this Court of the law applicable to determine invention in "chemical combinations." Over the years in a series of cases the rule as to mechanical combinations has been well established so that it is possible to determine whether a particular combination of mechanical elements amounts to invention or is merely aggregation. However, as evi-

---

[2] "The ability to predict results without experiment is a minimum with chemical compounds especially in the organic field and a maximum with chemical inventions." (See Ellis "Patent Claims" p. 576.) In the same comprehensive text not a single court decision is cited in the section entitled "Aggregation and Combination in Composition of Matter Claims." (Id. p. 599.)

denced by the lack of the citation of any authority in the opinion of the Court of Appeals here in question, there is no corresponding definite rule where chemical ingredients instead of mechanical elements are brought together.

2. Such a pronouncement is not only desirable for the instruction of the courts (and of the Patent Office) in dealing with chemical cases, but for the chemical industry as well. It is well known that major strides have been made by the American chemical industry since World War I. Those strides have been concerned largely with the synthesis of new chemical compounds and the development of and improvement in processes for the manufacture of known compounds. In recent years, the development of the chemical art has taken on a new complexion, that is, the achievement of specific results by the combined use of separate chemicals, each known to be useful for a particular purpose, but which when used together have a synergistic effect to produce a result not possible by the use of either alone.

3. It is well known and has long been recognized by the courts that while the results obtainable by the combination of mechanical elements may be determined by calculation, such determination beforehand is not true in the case where chemical ingredients are brought together. Accordingly it is only by experimentation that the effect of chemical combinations can be ascertained. It is important to know whether, just because a new and unexpected result is obtained by experimentation, such a discovery is to be denied the status of a patentable invention.

CONCLUSION.

For all of the foregoing reasons it is submitted that this petition for writ of certiorari should be granted.

Respectfully,

PETER S. ASSEFF AND
THE LUBRIZOL CORPORATION,

By JOHN F. OBERLIN,
ALMON S. NELSON,
Attorneys for Petitioners.

July 25, 1951.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

OPINIONS BELOW.

The opinion of the District Court (R. 13A *et seq.*) is reported in 86 F. Supp. 419 (1949). The opinion of the Circuit Court of Appeals (R. 202A *et seq.*) is reported in 89 U. S. P. Q. 206.

JURISDICTION.

The petition sets forth on page 2 the grounds upon which the jurisdiction of this Court is invoked.

STATUTE INVOLVED.

R. S. Sec. 4915 (35 U. S. C. 63) authorizing the action is printed as an appendix to this brief.

STATEMENT.

As indicated in the petition under Matter Involved, the claims of the Asseff patent application (R. 114A *et seq.*) may be divided into two groups. The first group, claims 1 to 5, were concerned broadly with the use in lubricating compositions of a certain specifically identified inhibitor with a detergent. While the original appeal related to both groups, the present petition is concerned only with the claims of the second group of which the following may be taken as typical:

> "9. A lubricating composition containing a characterizing amount of the product obtained by preparing the zinc salt of the reaction product of capryl alcohol with phosphorus pentasulphide and a separate detergent of the class consisting of oil-soluble organic compounds containing a metal atom directly attached to an element of the class consisting of oxygen and sulphur."

Lubricants thus defined are designed primarily for use under conditions of extreme stress such as high tem-

perature and pressure which are encountered for example in Diesel engines. When a refined, but chemically unfortified, mineral lubricating oil is used under such conditions of extreme stress, the oil will deteriorate, resulting in (1) the generation of acidic bodies which are corrosive and (2) the formation of deposits within the combustion chamber which impair operation of the engine.

The above quoted claim 9 of Asseff calls for the addition to or combination with a lubricating composition of two separate chemical ingredients. The first of these, which may be generally termed an inhibitor, is a chemical compound containing phosphorus, sulphur and zinc which reacts with the metal surfaces, such as the engine parts, to build up thereon a barrier film that physically excludes the acidic bodies formed in the lubricating oil from attacking the metal. The second added ingredient, defined as a detergent, is designed to prevent the deposition of gum and carbon, or minimize the formation of deposits which interfere with normal engine operation. It is essential that these two added ingredients be compatible, for if either interferes with the chemical action of the other no improvement in the lubricating oil is obtained. What Asseff discovered was that the specific inhibitor, defined as in the above quoted claim, was not only compatible with the detergent compound, but that such inhibitor cooperates with the latter in an unexpected way to keep the engine very much cleaner than would be possible were such detergent used alone.

At the time Asseff made this invention, two skilled workers in the art, Cook and Thomas, filed an application (R. 164A *et seq.*) for patent in which they were concerned with the use, by itself, in refined mineral oil of a material generally similar to the inhibitor component of the Asseff combination. In that patent application, Cook and Thomas said that this type of material could not be used in combination with an inhibitor because (R. 167A):

> "The function of a corrosion inhibitor is to cover the bearings and other corrodible surfaces of the automo-

bile engine with a passivating film that prevents corrosion of the metal by the organic acids and other corrosive oxidation products in the oil. On the other hand, a sludge inhibitor or a detergent as the name implies operates to remove adhering solids from the metal parts of the engine and thus to produce a clean metal surface. *Consequently, the use of a corrosion inhibitor in admixture with the detergents heretofore employed has proven to be ineffective over any extensive period of time, as each chemical tends to offset the action of the other.*" (Emphasis added.)

It is admitted that in the matter of date the foregoing Cook application is prior to Asseff's discovery. However such Cook application was abandoned and it was only in an application (now patent No. 2,344,392, R. 183A), filed by Cook subsequently to Asseff's discovery, that Cook for the first time recognized the possibility of combining his specific inhibitor with certain identified detergents.[3]

On the basis of the foregoing, two members of the Court of Appeals in ruling on Asseff's claims 9 to 24 here in issue, stated (Opinion p. 3):

"The fact that Cook's first application said the detergent and the anti-corrosion agent would offset each other might have the effect of showing that Cook was not prior art as to Asseff's Claims 9 to 24, if those claims were otherwise patentable; but that group of claims was rejected over the Cook and Salzberg patents in view of the patents to Wilson and McNab, which disclose the use of corrosion inhibitors in combination with detergent agents similar to those disclosed by Asseff.

"We see no invention in adding to the Cook composition well known detergents or corrosion inhibitors, as doing so is 'the result of a natural course of experimentation using the knowledge of prior patents.' *Asseff v. Kingsland*, 85 U. S. App. D. C. 367, 368, 178 F. (2d) 710, 711."

---

[3] In the interval this had been disclosed but not claimed in Asseff's patent No. 2,261,047 (R. 177A).

However District Judge Wilkin[4] (retired) sitting by designation, sharply dissented (Opinion, p. 3):

> "The evidence is clear that Asseff was first in reducing to practice the specific ingredients that produced the desired result and constituted the invention. It seems contrary to the very spirit and purpose of patent law to allow the subsequent application of Cook the benefit of the earlier date of his application, the teaching of which was expressly contrary to the combination which constituted the invention."

Even had it been known (the contrary is the fact here) that corrosion inhibitors and detergents could be used together as additives in a lubricating composition, it would still be invention to discover a specific combination of such ingredients in which the corrosion inhibitor promoted, as it does in the Asseff composition, the action of the detergent. This clearly was a surprising and unexpected result.

SPECIFICATION OF ERRORS TO BE URGED.

The Circuit Court of Appeals erred:

1. In failing to define and apply a proper rule as to what constitutes patentable invention in the case of "chemical combinations."

2. In allowing the subsequent application of Cook the benefit of the date of his earlier application, the teaching of which was expressly contrary to the combination which constituted the invention here claimed.

3. In holding that Asseff's combination is anticipated by taking together prior art patents which show the use in lubricants of detergents and the Cook patent which is based on an application which contains the specific statement that inhibitors and detergents cannot be used in combinations since each such component offsets the action of the other.

---

[4] Judge Wilkin, during over ten years service as a judge of the United States District Court, Northern District of Ohio, was recognized as specially qualified in the trial of patent cases.

4. In failing to hold that the claims of the Asseff patent which are directed to a combination of components which unexpectedly cooperate in providing desirable results, far beyond the cumulative effect when such components are used separately, ~~do not~~ define a patentable invention.

5. In affirming the order of the District Court.

ARGUMENT.

This petition reveals the existence of an important area in the field of patent law, wherein the decision below, if allowed to stand, materially and adversely affects a large and constantly growing segment of American industry, namely that concerned with the discovery and exploitation of new chemical compositions.

With respect to patents on mechanical combinations, this Court, by Mr. Justice Matthews, as far back as 1881, in *Pickering v. McCullough,* 104 U. S. 318 (1881) clearly defined what constituted patentable invention:

> "In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of invention, seized each of every part, per my et per tout, and not mere tenants in common, with separate interests and estates. It must form either a new machine of a distinct character and function, or produce a result due to the joint and cooperating action of all the elements, and which is not the mere adding together of separate contributions."

In the case of *Grinnell Washing Mach. Co. v. E. E. Johnson,* 247 U. S. 426, 432, 62 L. Ed. 1196, 1199 (1918), the Supreme Court said:

> "Generally speaking a combination of old elements in order to be patentable must produce by their joint action a new and useful result or an old result in a more advantageous way. To arrive at the distinctions between combinations and aggregations definite reference must be had to the decisions of this court."

There is a long line of cases which have laid down the rules to be followed in determining whether a particular combination of mechanical elements amounts to invention or is merely an aggregation.

If the law thus clearly established in mechanical cases were to be applied to the facts in the present case, there would result a clear ruling that what Asseff did amounted to invention. He brought together for the first time the components defined by the claims. They cooperate, and the results of such cooperation is a truly synergistic effect which cannot be secured by the use of either of the components alone, nor is the new synergistic effect merely the cumulative effect of the two components when used alone. However, the lower court in affirming the trial court held that this was not invention. The lower court cited no cases in support of its position. One would, therefore, be led to the assumption that the rule applicable to mechanical cases does not hold when considering chemical cases. There are no comparable holdings by this Court in which there ~~has~~ *ha* been laid down the criteria which determine invention in "chemical combinations." The urgent need for such a rule is self-evident.

Is it to be the rule, as in mechanical cases, that whenever an inventor brings together two chemical substances and observes unexpected cooperation or synergistic effect he has made an invention?

Or shall a new standard of invention be applied to chemical cases which, if the doctrine of the decisions of the lower court in the present case were to be followed, would practically preclude recognizing invention in any combination of chemical compounds regardless of how startling the unexpected results may be, since it could always be said that someone at some time in the future as a result of experimentation would probably put together these two materials?

If the rule to be followed in measuring invention in "chemical combinations" is to be different from the rule

to be followed in measuring invention in mechanical combinations, a definition of the new standard should be provided. If no different standards of invention are to be applied, then a pronouncement to that effect is required also.

CONCLUSION.

The court below has failed to recognize in the case of a chemical combination any rule of patentable invention comparable to that which has long been established by this Court in the case of mechanical combinations. It has compounded this error by refusing to recognize invention in a combination of chemical ingredients which the prior art taught could not be achieved.

The writ of certiorari prayed for should be granted.

Respectfully submitted,

JOHN F. OBERLIN,
ALMON S. NELSON,
Attorneys for Petitioners.

July 25, 1951.

APPENDIX.

Sec. 4915 R. S. (35 U. S. C. Sec. 63).

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, may have remedy by bill in equity, if filed within six months after such refusal or decision; * * * (R. S. 4915). (Mar. 2, 1929, c. 488, sec. 2(b), 45 Stat. 1476; August 5, 1939, c. 451, sec. 4, 53 Stat. 1212.)